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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,810	03/23/2004	David I. Suda	D0932-00444	2913
8933	7590	01/26/2006	EXAMINER	
DUANE MORRIS, LLP IP DEPARTMENT 30 SOUTH 17TH STREET PHILADELPHIA, PA 19103-4196			YAO, SAMCHUAN CUA	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,810

Applicant(s)

SUDA ET AL.

Examiner

Sam Chuan C. Yao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 17-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 36-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/24/04 & 1/9/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16 and 36-43, drawn to an insulating product, classified in class 442, subclass 331.
 - II. Claims 17-35, drawn to a wood product, classified in class 156, subclass 62.2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as forming a pair of insulating layers and a fibrous reinforcing core layer, and then impregnating the combinations of layers with a binding agent.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Joseph Powers on 01-12-06 a provisional election was made without traverse to prosecute the invention of Group I (claims 1-16 and 36-43). Affirmation of this election must be made by applicant in

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replying to this Office action. Claims 17-35 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Information Disclosure Statement

5. The references cited by Applicant on the 1449's have been made of record.

While the statements filed clearly do not comply with the guidelines set forth in MPEP 2004 regarding both the number of references cited and elimination of clearly irrelevant art and marginally pertinent cumulative information, compliance with these guidelines is not mandatory. Furthermore, 37 CFR 1.97 and 1.98 do not require that the information be material, rather they allow for submission of information regardless of its pertinence to the claimed invention. Also, there is no requirement to explain the materiality of submitted references, however, the cloaking of a clearly relevant reference by inclusion in a long list of citations may not comply with Applicant's duty of disclosure, see *Penn Yan Boats, Inc. v. Sea Lark Boats Inc.*, 359 F. Supp. 948, *aff'd* 479 F. 2d. 1338.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-16 and 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite, because it is unclear how a reinforcing layer can be bonded between major surfaces of a fibrous mat. For the purpose of examining this claim, a reinforcing layer is assumed to be disposed between each major surface of fibrous webs from a multi-layered mat.

Claim 37 is indefinite, because it is unclear whether the "plurality of nonwoven sheets" recited in this claim are distinct from the "at least one nonwoven sheet" recited in claim 36. For the purpose of examining this claim, it is assumed that

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the non-woven sheets recited in this claim are additional and distinct from the "at least one nonwoven sheet" recited in claim 36.

Claim 38 is indefinite, because the phrase "said plurality of non-woven layers" do not have a positive antecedent basis. For the purpose of examining this claim, it is assumed that these nonwoven layers are referring to the "plurality of non-woven sheets" recited in claim 37. For this reason, this claim is taken to require disposing **additional two insulation layers and two non-woven layers between** the non-woven sheets in claim 37.

Claim 39 is indefinite, because the limitation in this claim is limitation in this claim is confusing. Does this limitation in this claim require the "*plurality of nonwoven sheets*" to further comprise "*at least three insulating layers and at least three nonwoven layers*" (note the phrase "...*from said plurality of nonwoven sheets*"(bold-face added)).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 1 and 36 are rejected under 35 U.S.C. 102(b) as anticipated by Shannon (US 4,201,247). See figure 5, abstract, column 9 lines 39-62.

The alternating resin-impregnated crystallizable mineral fibrous layers (154,155) are taken to be the recited stacked of insulating layers; the pair of amorphous glass fiber

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facing layers (151,152) are taken to be the recited "at least one nonwoven facing", and the amorphous glass fiber central layer (153) is taken to be the recited "at least one nonwoven sheet."

10. Claims 1-5, 7-8, 10, and 36-37 are rejected under 35 U.S.C. 102(b) as anticipated by Pellegrin et al (US 5,900,206).

With respect to claim 36, Pellegrin et al discloses a process of making a fibrous pack which is useful for making articles such as an insulating batt (abstract; column 1 lines 21-44; col. 7 lines 55-67). The process comprises: a) depositing a 1st veil of glass fibers onto a conveyor belt to form a 1st fiber glass non-woven web (taken to be the recited nonwoven facing layer); b) depositing a 1st melt-blown polymeric fibers onto the 1st fiber glass web to form a 1st polymeric layer; c) depositing a 2nd veil of glass fibers (taken to be one of the recited "*stacked insulation layers*") onto the 1st polymeric layer to form a 2nd fiber glass non-woven web; d) depositing a 2nd melt-blown polymeric fibers onto the 2nd fiber glass web to form a 2nd polymeric layer; e) depositing a 3rd veil of glass fibers onto the 2nd polymeric layer to form a 3rd fiber glass non-woven web (taken to be the recited nonwoven sheet); f) depositing a 3rd melt-blown polymeric fibers onto the 3rd fiber glass web to form a 3rd polymeric layer; g) depositing a 4th veil of glass fibers onto the 3rd polymeric layer to form a 4th fiber glass non-woven web; h) depositing a 4th melt-blown polymeric fibers onto the 4th fiber glass web to form a 4th polymeric layer; and, i) depositing a 5th veil of glass fibers onto a conveyor belt to form a 5th fiber glass non-woven web (taken to be 2nd of the recited

"stacked insulation layers"); wherein the deposited veils of glass fibers may be thermosetting resin binder such as a urea phenol formaldehyde (col. 4 lines 34-46; col. 6 line 66 to col. 7 line 10; figure 1).

Since claim 36 does not positively require the recited nonwoven facing layer to be contiguous to a major surface of a mat comprising insulation layers, this fails to distinguish over the 1st fiber glass nonwoven web (taken to be a facing layer) and 2nd fiber glass non-woven web (taken to be one of insulating layers) adhering to each other via the 1st polymeric layer.

With respect to claim 37, the 3rd and 4th fiber glass non-woven webs are taken to be the recited "plurality of nonwoven sheets"

With respect to claims 1-4, the 3rd and/or 4th fiber glass non-woven webs are taken to be the at least one flexible reinforcing layer recited in these claims.

With respect to claim 5, the 3rd polymeric layer is taken to be the randomly oriented fibers recited in this claim.

With respect to claims 7-8, 1st, 3rd and 5th fiber glass non-woven webs are taken to be the recited three stacked insulation layers, while the 2nd and 4th fiber glass nonwoven webs are taken to be the "at least one flexible reinforcing layer".

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 9,11-16 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pellegrin et al (US 5,900,206) as applied to claim 1 or 36 in numbered paragraph 10 above.

With respect to claims 9 and 11, the recited R-value in these claims are conventional in the art. One in the art would have applied a suitable R-value for the desired end-use of a finished insulating article.

With respect to claims 12-14, fiber glass binding agent which has a curing temperature range recited in claim 12 is well known in the art. Also see figure 1, column 5 lines 25-40, and column 7 lines 11-24, where it discloses polymeric fibers and glass fibers being blended together and also shows thermoplastic materials (e.g. polypropylene) which have a melting range that are significantly lower than a curing temperature range recited in claim 12.

With respect to claims 15-16 and 41-42, the limitations in these claims are notoriously well known in the art of making an fibrous insulating batt.

Allowable Subject Matter

13. Claim 6 and 40 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: there is no suggestion in the art to modify a fibrous insulating article such that the article is separable between reinforcing layers or nonwoven sheets.

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Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Richard Crispino can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

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01-23-06